

09/681,050

MS131754.01/MSFTP282US

REMARKS

Claims 1-1 and 13-30 are currently pending in the subject application and are presently under consideration.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-11 and 13-26 Under 35 U.S.C. §101

Claims 1-11 and 13-26 stand rejected pursuant to 35 U.S.C. §101 under contention that the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is respectfully requested for at least the following reasons. In the Office Action dated May 12, 2005, it is asserted that "claims 1, 11, and 24 do not contain positive recitation of a computer in the body of the claims to breath life and meaning into the preamble. However, claims 1, 11, and 24 were amended in the Reply to the Office Action dated January 25, 2005 to emphasize in the bodies of the claims that the invention is directed to computer-implemented methods employing *computer-implemented component(s)*. This rejection should be withdrawn.

II. Rejection of Claims 1, 9 and 28 Under 35 U.S.C. §102(e)

Claims 1, 9 and 28 stand rejected under 35 U.S.C. §102(e) as being anticipated by Grosser *et al.* (US 6,826,552). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Grosser, *et al.* does not teach or suggest each and every limitation of applicants' claimed invention.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention relates to methods and systems for identifying a sub-population of a population to solicit and a sub-population of the population not to solicit that will maximize

09/681,050

MS131754.01/MSFTP282US

profits for an advertiser performing solicitation. For instance, applicants' claimed invention can take a sample of a population of potential purchasers, divide the sample into a solicitation group and a non-solicitation group, and solicit the solicitation group. Tracking of purchases and non-purchases by members of each group allows for a model to be constructed that can be used against the entire population to identify a sub-population to solicit and a sub-population not to solicit that will maximize profits. Applicants' claimed invention minimizes solicitation of members who will not make a purchase, who are already planning on buying, and/or who planned on buying but will not buy if solicited, thereby reducing cost of solicitation. The method also increases solicitation to a subset of members who will buy if solicited, thereby maximizing purchases. In particular, as recited in independent claims 1 and 28, applicants' claimed invention employs a computer-implemented component to *identify the sub-population to solicit and a non-solicited sub-population by using a computer-implemented decision theoretic model, the decision theoretic model constructed to maximize an expected increase in profits;... and sets a purchase variable to a first value for each of the plurality of members of the solicitation and the non-solicitation sub-population that made a purchase and to a second value for each of the plurality of members of the solicitation and the non-solicitation sub-populations that did not make the purchase.*

Grosser, *et al.* does not teach or suggest the aforementioned novel aspects of applicants' claimed invention. Rather, Grosser, *et al.* discloses a computer aided decision making system that assists a user in making a decision regarding large purchases, such as a home or automobile. Applicants' claimed invention is focused on aiding a seller/advertiser in making a decision on which members of a group of potential buyers should be sent a solicitation/advertisement. However, the prior art is focused on aiding a buyer in making a purchase decision concerning several purchase options. The system of Grosser, *et al.* will employ a search engine to seek out purchase proposals that meet a user's requirements. The system further allows the user to solicit input from one or more advocates (family member, friend, etc.) on proposals. The system allows advocates who are not solicited to provide input. These advocates provide their opinions on the proposals, but are not themselves making purchases. The user is then able to evaluate the proposals and the feedback from advocates, and reject proposals. The section of prior art cited in the Office Action discloses a screen that displays proposals that the user has rejected and proposals still being considered. This is merely a means for the user to track status of proposals

09/681,050

MS131754.01/MSFTP282US

being considered. Grosser, *et al.* does not teach a user of the system sending solicitations to potential buyers and then setting a purchase variable to a first value for those potential buyers that made a purchase and setting the purchase variable to a second value for those potential buyers that did not make a purchase as in applicants' claimed invention. Rather, the reference teaches sending solicitations to advocates for feedback and does not set any purchase variable for each advocate. Grosser, *et al.* is not concerned with purchase decisions of advocates, but instead gathering input from the advocates so that the user of the system can make a purchase decision. Therefore, Grosser, *et al.* does not teach or suggest *setting a purchase variable to a first value for each of the plurality of members of the solicitation and the non-solicitation sub-population that made a purchase and to a second value for each of the plurality of members of the solicitation and the non-solicitation sub-populations that did not make the purchase* as in applicants' claimed invention.

Furthermore, Grosser, *et al.* does not teach or suggest *identifying the sub-population to solicit and a non-solicited sub-population by using a computer-implemented decision theoretic model, the decision theoretic model constructed to maximize an expected increase in profits.* Applicants' claimed invention teaches a system that identifies a sub-population to solicit and a sub-population not to solicit by employing a decision theoretic model. The model identifies the solicited and non-solicited sub-populations based upon how solicitation will maximize profits for the advertiser. Grosser, *et al.* is concerned with assisting a buyer in determining where to purchase from multiple proposals possibly from a variety of sellers. The cited reference simply teaches soliciting advocates for feedback concerning purchase proposals, not for the advocates to make a purchase. Grosser, *et al.* does not identify the solicited and non-solicited advocates by employing a decision theoretic model. Rather, the reference discloses that the user of the system chooses which advocates to solicit for feedback. Furthermore, the Office Action suggests that the decision making system of Grosser, *et al.* leads a customer to buy an item, which in turn increases profit. However, the motives of a buyer and seller are not aligned in terms of maximizing profit. The prior art is concerned with a purchase decision of the buyer, which is typically focused on obtaining the correct item at the lowest cost possible. This will lead to minimizing seller profit. The seller is attempting to sell the product at the highest price that still results in a sale, while also minimizing costs associated with selling in order to maximize profit. Therefore, contrary to assertions in the Office Action, Grosser, *et al.* does not inherently teach or

09/681,050

MS131754.01/MSFTP282US

suggest identifying the sub-population to solicit and a non-solicited sub-population by using a computer-implemented decision theoretic model, the decision theoretic model constructed to maximize an expected increase in profits

In view of at least the foregoing, applicants' representative respectfully submits that Grosser, *et al.* fails to teach or suggest all limitations of applicants' invention as recited in independent claims 1 and 28 (and claim 9 that depends there from), and thus fails to make obvious the claimed invention. Therefore, this rejection should be withdrawn.

III. Rejection of Claims 2-8, 11, 13-27, 29 and 30 Under 35 U.S.C. §103(a)

Claims 2-8, 11, 13-27, 29 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Grosser *et al.* as applied to claim 1 above, and further in view of Kohavi (US 6,182,058). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Grosser, *et al.* nor Kohavi, alone or in combination, teach or suggest each and every limitation of applicants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claims 11 and 24 (similarly to independent claims 1 and 28) recite *setting the purchase variable to the first value for each of the plurality of members of the solicitation and the non-solicitation groups that made a purchase and to the second value for each of the plurality of members of the solicitation and the non-solicitation groups that did not make the purchase; ... applying the decision tree against the population to identify the sub-population to*

09/681,050

MS131754.01/MSFTP282US

solicit to maximize the expected increase in profits. As discussed *supra* with respect to independent claims 1 and 28, Grosser, *et al.* fails to teach or suggest these novel features of the subject claims. Furthermore, Kohavi fails to make up for the deficiencies of Grosser, *et al.* with respect to these claimed features. Rather, Kohavi discloses a hybrid classifier, called the NB-Tree classifier, for classifying a set of records. In an example, Kohavi teaches a marketing campaign where responses are tracked to determine who is likely to respond. However, Kohavi fails to teach a purchase variable that is set with a first value for purchase and a second value for non-purchase. A likeliness to respond is not analogous to a purchase. A recipient of the marketing campaign may respond, such as to request more information or look at a product, without ever making a purchase. Moreover, Kohavi fails to mention purchase or buy anywhere in the patent. Furthermore, Kohavi discusses reducing costs associated with the marketing campaign, but reducing costs is not equivalent to maximizing profit. Reducing costs increases profits, but does not necessarily maximize profits. Maximizing profit from a solicitation results from increasing purchases, avoiding discounting prices, and reducing solicitation costs.

Therefore, Grosser, *et al.* and Kohavi do not teach or suggest setting the purchase variable to the first value for each of the plurality of members of the solicitation and the non-solicitation groups that made a purchase and to the second value for each of the plurality of members of the solicitation and the non-solicitation groups that did not make the purchase;... and applying the decision tree against the population to identify the sub-population to solicit to maximize the expected increase in profits as in applicants' claimed invention.

Claims 2-8 and 29-30 depend from independent claims 1 and 28 respectively. As discussed above with respect to independent claims 11 and 24, Kohavi fails to cure the above noted deficiencies of Grosser, *et al.* regarding independent claims 1 and 28.

In view of at least the above, it is respectfully submitted that Grosser, *et al.* and Kohavi, alone or in combination, fail to teach or suggest all aspects of applicants' invention as recited in independent claims 1, 11, 24, and 29 (and claims 2-8, 13-23, and 25-27 that depend there from), and thus fails to make obvious the subject claimed invention. This rejection should be withdrawn.

09/681,050

MS131754.01/MSFTP282US

IV. Rejection of Claim 10 Under 35 U.S.C. §103(a)

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Grosser *et al.* as applied to claim 1 above, and further in view of Cooper *et al.* (US 5,737,416). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The cited art, alone or in combination, do not teach or suggest each and every feature of applicants' claimed invention.

Claim 10 depends from independent claim 1. Cooper, *et al.* fails to cure the above noted deficiencies of Grosser, *et al.* with respect to independent claim 1. Cooper, *et al.* discloses a system for allowing a producer of software to provide a trial period for use of the software when a potential buyer initiates a request for said software, while maintaining security over the files to prevent piracy. Cooper fails to teach or suggest solicitation and non-solicitation sub-populations and maintaining a purchase variable for members of each group, as well as failing to mention maximizing profit. Cooper, *et al.* is silent regarding setting the purchase variable to the first value for each of the plurality of members of the solicitation and the non-solicitation groups that made a purchase and to the second value for each of the plurality of members of the solicitation and the non-solicitation groups that did not make the purchase;... and applying the decision tree against the population to identify the sub-population to solicit to maximize the expected increase in profits as in the claimed invention.

Accordingly, withdrawal of this rejection is respectfully requested.

09/681,050

MS131754.01/MSFTP282US

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP282US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731